

**REMARKS**

This Response and Amendment is made in a good faith effort to place the claims in better condition for appeal and to place the application in better condition for allowance.

**1. Specification Amendments.**

The Examiner objected to the drawings for failing to show "axis A". The offending portion of the specification has been amended to delete such reference.

The Examiner objected to the drawings for failing to show every feature of the invention specified in the claims. Applicant has amended the claims accordingly.

Applicant notes that the Examiner objected to the specification for failing to provide antecedent basis for "feed water inlet". Applicant has amended the specification at page 10, lines 4-15 to provide such basis. The Examiner objected to the specification for failing to recite several terms in the claims. Applicant has amended the claims to remove such terms. No new matter has been added.

Some of the issues regarding the specification raised by the Examiner on Page 3 of the Office Action were addressed in the response to the previous Office Action, and Applicants direct the Examiner's attention to the previous response dated 19 April 2005.

**2. Claim Amendments.**

Claim 1 has been amended to correct for informalities and to more accurately reflect the present invention. Specifically, Claim 1 has been amended to clarify that the **elongated member** of the device provides a handle to users of the water structure and that the handle is above the surface of the water (see page 2, lines 22-24).

Claims 2 and 3 have not been amended in this Response.

Claim 4 was previously cancelled.

Claim 5 has not been amended in this Response.

Claim 6 has been amended to correct for informalities.

Claims 7 and 8 were previously cancelled.

Claims 9 - 14 have not been amended in this Response.

Claim 15 has been amended to correct for informalities.

Claim 16 was previously cancelled.

Claim 17 has been amended to correct for informalities and to more accurately reflect the present invention. Specifically, Claim 17 has been amended to clarify that the **elongated member** of the device provides a handle to users of the water structure and that the handle is above the surface of the water (see page 2, lines 22-24).

Claim 18 was previously cancelled.

Claim 19 has been amended to correct for informalities and to more accurately reflect the present invention. Specifically, Claim 19 has been amended to clarify that the **elongated member** of the device provides a handle to users of the water structure and that the handle is above the surface of the water (see page 2, lines 22-24).

Claim 20 has been amended to correct informalities.

Claims 21-32 have not been amended in this Response.

Claim 33 has been amended to correct for informalities and to further clarify the present invention.

No new matter has been added in any of these amendments.

### 3. 35 USC 102 Anticipation.

Claims 1-3, 5, 6, 17, 19-23 and 25-30 have been rejected under 35 USC 102(b) as being anticipated by US Patent No. 5893179 to Johnson (Johnson '179). Claims 1-3, 5, 6, 9-15, 17, and 19-30 have been rejected under 35 USC 102(b) as being anticipated by US Patent No. 5537696 to Chartier (Chartier '696). Claims 1-3, 5, 6, 31, 32, 17, 19-23 and 25-30 have been rejected under 35 USC 102(b) as being anticipated by US Patent No. 1398941 to Gable (Gable '941). Applicant respectfully submits that none of the cited arts anticipate the currently amended claims.

Anticipation under 35 USC 102(b) requires "the disclosure in a prior art reference of each and every element of the claimed invention." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); *see also verdegall Bros. V. Union Oil Co. of California*, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). The absence of one element from the cited prior reference negates anticipation. *See Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 USPQ2d 409 (Fed Cir.

1984). As discussed below, each and every element of the claims of the present patent application is *neither* found in Johnson '179 *nor* in Chartier '696.

**A. US Patent No. 5893179 To Johnson Does Not Anticipate The Present Invention As Disclosed And Claimed.**

Currently amended Claim 1 includes limitations that **the end pieces hold the elongated member at a distance from the water structure so that the elongated member functions as a handle** for a user of the water structure and that the handle is above the surface of the water. Applicant submits that Johnson '179 fails to disclose such elements and that this claim is therefore allowable. Further, Applicant can ascertain no impetus that a person of ordinary skill in the art would modify Johnson '179 such that it met the above conditions as there would be no benefit to the waterfall device of Johnson '179 by so spacing it. This is not unexpected, as there is no reason to suspect that Johnson '179 intended to teach a waterfall handle as in the present invention.

The Examiner alleges that elements 42 and 44 of Johnson '179 are capable of being used as a handle. Applicant respectfully disagrees. Nowhere in the disclosure of Johnson '179 does it indicate that elements 42 or 44 are designed or intended for such use. Elements 42 and 44 merely are the covers for the waterfall producing aspect of the invention. Further, it would be anathema to assume that anyone would place their fingers in the waterfall water outlet, even if the fingers could fit, which they could not. However, even if elements 42 or 44 could serve such a purpose, there is clearly no disclosure in Johnson '179 of an elongated member which is spaced from the water structure that functions as a handle as in the currently amended claim. As can be seen in FIGs. 1 and 6 of the pending application, the end pieces hold the elongated center section at a distance from the water structure such that there is a space between the elongated center section and the water structure for accommodating the user's hand. Such a spacing allows a user to place his fingers between the wall and the elongated member. Thus, a user is able to grasp the device so that he may raise or lower himself by using the elongated member as a handle rather than just being able to push off of a horizontal surface. Such ability to grasp lends to a much more useful device than the disclosures of the prior art cited by the Examiner.

Applicant submits that there is no disclosure in Johnson '179 allowing a user to place his fingers between any portion of the device and the water structure wall. Applicant respectfully submits that because Johnson '179 fails to disclose each and every element of Applicant's currently amended claim 1, the Examiner should remove the rejection and find the claim allowable.

Further, Claims 2, 3, 5, and 6 depend from independent Claim 1 and are therefore allowable for the same reasons that Claim 1 is allowable.

Claims 9-15 were not rejected over Johnson '179.

Currently amended Claim 17 also includes the limitations that **the end pieces hold the elongated member at a distance from the water structure so that the elongated member functions as a handle** for a user of the water structure and that the handle is above the surface of the water. Applicant submits that Johnson '179 fails to disclose such elements and that this claim is therefore allowable.

Currently amended Claim 19 also includes the limitations that **the end pieces hold the elongated member at a distance from the water structure so that the elongated member functions as a handle** for a user of the water structure and that the handle is above the surface of the water. Applicant respectfully submits that Johnson '179 fails to disclose such elements and that this claim is therefore allowable.

Further, Claims 20-23 and 25-30 depend from independent Claim 19 and they are similarly allowable for the same reasons that Claim 19 is allowable.

Claim 24 and claims 31-33 were not rejected over Johnson '179.

For the above reasons, Applicant requests that the Examiner remove the rejections and find the claims allowable.

**B. US Patent No. 5537696 To Chartier Does Not Anticipate The Present Invention As Disclosed And Claimed.**

Claims 1-3, 5, 6, 9-15, 17, and 19-30 have been rejected under 35 USC 102(b) as being anticipated by US Patent No. 5537696 to Chartier (Chartier '696). Applicant respectfully submits that Chartier '696 does not anticipate the currently amended claims.

As discussed above, anticipation under 35 USC 102(b) requires "the disclosure in a prior art reference each and every element of the claimed invention." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986);

see also *verdegall Bros. V. Union Oil Co. of California*, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). The absence of one element from the cited prior reference negates anticipation. See *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 USPQ2d 409 (Fed Cir. 1984). As discussed below, each and every element of the claims of the present patent application is *not* found in Chartier '696.

Chartier '696 discloses a waterfall which is mounted to a sidewall or under the decking of a pool. More specifically, Chartier '696 discloses that the "invention relates to **modules incorporated in the side walls** and connected to the plumbing of swimming pools..." Column 1, lines 13-14 (emphasis added). Chartier '696 also indicates that, in a preferred embodiment, **the back portion of the device is "adapted to fit into and form part of the pool structure."** Column 1, lines 56-57 (emphasis added). Finally, FIG. 5 of Chartier '696 (reproduced below), illustrates the "apparatus installed in a typical environment." Column 2, line 45.

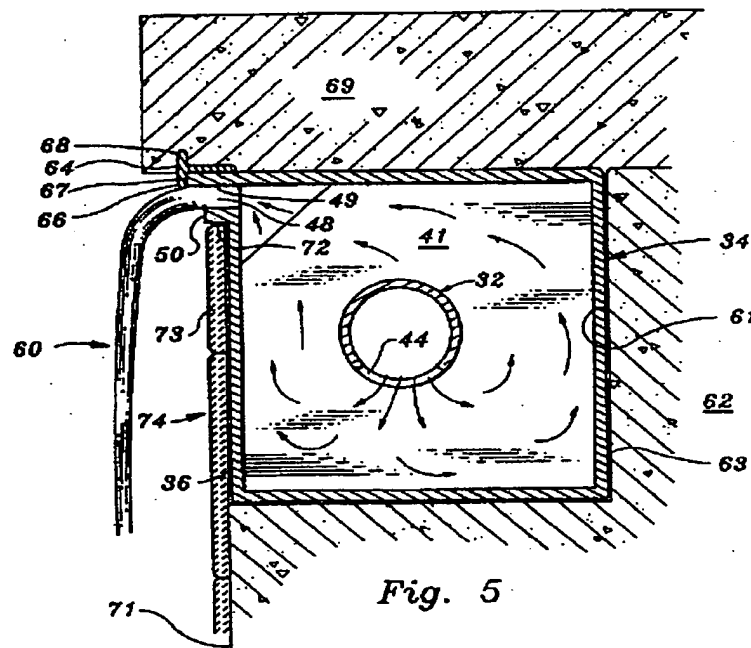


Figure 1: Chartier '696

As disclosed, the device of Chartier '696 is installed directly into the wall of the pool and there is no space between the device and the pool wall. Further, as shown, the device would not be suitable as a handle as it is situated under pool decking and/or flushly affixed to a wall.

As further disclosed in Chartier '696:

Since the apparatus of the present invention provides a sheet waterfall by a short, overhanging upper lip construction, as previously described, economies of construction, without a sacrifice of strength, are obtained. In other words, **as appears most clearly in FIG. 5, the manifold 34 is readily fitted into a pre-cut notch 61 in the bond beam 62 around the perimeter of the pool or spa and secured with a bonding layer 63 of thin set concrete.**

If desired, an elongated key 64, T-shaped in transverse section, can be positioned horizontally so that one arm 66 of the T-shaped key 64 abuts the outer end 67 of the upper lip 49 and the other arm 68 of the key is located within a keyway formed in the beam 69, or deck coping. **Since the front portion 36 of the manifold 34 is flush with the pool or spa wall surface 71, the lower face 72 of the lower lip 50 provides an ideal upper abutment for the top course 73 of tile 74. Because of the short length of the lips 49 and 50 and the vertically co-planar construction of the outermost surfaces of the lower lip 50 and the tile 74, the sheet waterfall 60 appears to emerge directly from the tile and presents a most appealing visual effect.** At the same time, as a result of the short length of the lips, compact structural integrity and strength are maintained.

Chartier '696, column 6, lines 1-23 (emphasis added).

The Examiner alleges that element 49 of Chartier '696 is capable of being utilized as a handle, "at least by inserting fingers between surfaces 51, 52". Applicant respectfully disagrees. As mentioned above, it would be anathema to assume that anyone would place their fingers in the waterfall water outlet, even if the fingers could fit, which they could not. Chartier '696's FIG. 2 is shown below with elements 51 and 52 shown circled.

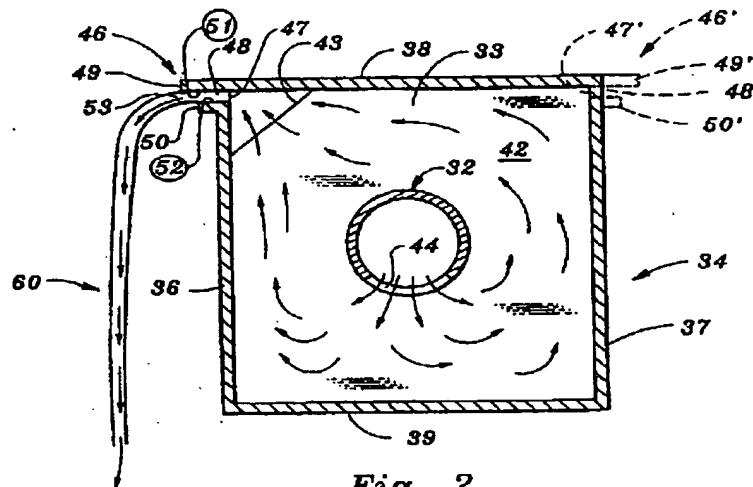


Figure 2: Chartier '696

Firstly, and as noted above, according to the disclosure of Chartier '696, element 49 is not even accessible to a user as it is below the pool's decking, so it could not possibly be utilized as a handle for a user to raise and lower himself. Secondly, it is hard to imagine a user inserting his fingers into a narrow opening in order to raise or lower himself when water is being propelled out of the opening. Applicant respectfully submits that such a use of Chartier's device is not only unreasonable, it is clearly beyond the scope of Chartier's disclosure and would be inherently dangerous to a user. Not only would such a narrow opening be hazardous and most likely contain sharp edges, but it is likely to be extremely slippery due to the constant waterflow out of the opening. Importantly, there is absolutely no teaching in Chartier '696 that would even hint to a user to stick his or her fingers in the outlet slot or to use it as a handle.

The Examiner also alleges that Chartier '696 may be suitable as a handle citing language at column 5, lines 49-55. Applicant is unable to ascertain **any** intended handle functionality from column 5 lines 49-55 of Chartier '696 which simply states that a potential embodiment may have a waterfall emitted from both sides of the device. There is no disclosure in Chartier '696 of the device being suitable as a handle or of the device being situated in any configuration in which an elongated member portion of the device is situated at any distance from a wall so that the device could be grasped by a user in order to allow the user to raise or lower himself.

Simply constructing the device of Chartier '696 to produce a waterfall on two sides does not change the fact that there is no suitable handle disclosed or presented in Chartier '696.

Applicant also notes that currently amended Claim 1 includes limitations such that **the end pieces hold the elongated member at a distance from the water structure so that the elongated member functions as a handle for a user of the water structure**, which are not found in Chartier '696.

Applicant respectfully submits that because Chartier '696 fails to disclose each and every element of Applicant's currently amended Claim 1, the Examiner should remove the rejection and find the claim allowable.

Further, Claims 2, 3, 5, and 6 depend from independent Claim 1 and are therefore allowable for the same reasons that Claim 1 is allowable.

Pending Claim 9 includes a limitation wherein **the elongated member is rotatable within the first end piece and the second end piece** and the rotation of the elongated member varies the direction of the waterfall. Applicant respectfully submits that the device of Chartier '696 does not disclose such elements and that based on the disclosures of Chartier '696 as enumerated above, such rotation is not possible due to the installation methods disclosed. As noted above, Chartier '696 discloses a permanently mounted waterfall device "secured with a bonding layer 63 of thin set concrete", thus it does not teach a device that is rotatable as in the pending claim. Further, as the device of Chartier '696 is placed directly along or inside of a wall, it cannot possible be rotated as in the present invention. Applicant respectfully submits that because Chartier '696 fails to disclose each and every element of Applicant's Claim 9, the Examiner should remove the rejection and find the claim allowable.

Further, Claims 10-15 depend from independent Claim 9 and are therefore allowable for the same reasons that Claim 9 is allowable.

Currently amended Claim 17 includes the limitations that **the end pieces hold the elongated member at a distance from the water structure so that the elongated member functions as a handle for a user of the water structure**. As noted above, Applicant respectfully submits that Chartier '696 fails to disclose such elements and that this claim is therefore allowable.

Currently amended Claim 19 includes the limitations that **the end pieces hold the elongated member at a distance from the water structure so that the**



**elongated member functions as a handle** for a user of the water structure. As noted above, Applicant respectfully submits that Chartier '696 fails to disclose such elements and that this claim is therefore allowable.

Further, Claims 20-23 depend from independent Claim 19 and they are similarly allowable for the same reasons that Claim 19 is allowable.

As stated above, Applicant respectfully submits that the disclosure of Chartier '696 does not disclose a rotatable device as in pending Claim 24, and this claim is thus allowable in addition to its dependency on Claim 19.

Claims 25-30 depend from independent Claim 19 and they are similarly allowable for the same reasons that Claim 19 is allowable.

Claims 31-33 were not rejected over Johnson '179.

For the above reasons, Applicant requests that the Examiner remove the rejections and find the claims allowable.

**C. US Patent No. 1398941 To Gable Does Not Anticipate The Present Invention As Disclosed And Claimed.**

Claims 1-3, 5, 6, 17, 19-23 and 25-32 have been rejected under 35 USC 102(b) as being anticipated by US Patent No. 1398941 to Gable (Gable '941). Applicant respectfully submits that Gable '941 does not anticipate the currently amended claims.

Currently amended Claim 1 includes limitations that **the end pieces hold the elongated member at a distance from the water structure so that the elongated member functions as a handle** for a user of the water structure. Applicant submits that Gable '941 fails to disclose such elements and that this claim is therefore allowable. Further, Applicant can ascertain no impetus that a person of ordinary skill in the art would modify Gable '941 such that it met the above conditions as there would be no benefit to the waterfall device of Gable '941 by so spacing it. This is not unexpected, as there is no reason to suspect that Gable '941 intended to teach a waterfall handle as in the present invention. Gable '941 is simply a faucet, is disclosed as a faucet, and there is absolutely no mention of its use as a handle or anything remotely similar. It is not structured to be a handle and may not even support the weight of a person. As such, Gable '941 teaches away from the present invention.

Applicant further notes that Gable '941 fails to disclose an elongated member as enumerated in currently amended Claim 1.

Applicant respectfully submits that because Gable '941 fails to disclose each and every element of Applicant's currently amended Claim 1, the Examiner should remove the rejection and find the claim allowable.

Further, Claims 2, 3, 5, and 6 depend from independent Claim 1 and are therefore allowable for the same reasons that Claim 1 is allowable.

Claims 9-15 were not rejected over Gable '941.

Currently amended Claim 17 also includes the limitations that **the end pieces hold the elongated member at a distance from the water structure so that the elongated member functions as a handle** for a user of the water structure. Applicant submits that Gable '941 fails to disclose such elements, as further enumerated above, and that this claim is therefore allowable.

Currently amended Claim 19 also includes the limitations that **the end pieces hold the elongated member at a distance from the water structure so that the elongated member functions as a handle** for a user of the water structure. Applicant respectfully submits that Gable '941 fails to disclose such elements as well as those enumerated above, and that this claim is therefore allowable.

Further, Claims 20-23 and 25-32 depend from independent Claim 19 and they are similarly allowable for the same reasons that Claim 19 is allowable. Further, Gable '941 fails to disclose a waterfall slot extending lengthwise across the majority of the length of the elongated member as in pending Claim 22.

Claim 24 and 33 were not rejected over Gable '941.

For the above reasons, Applicant requests that the Examiner remove the rejections and find the claims allowable.

**4. The Invention as Claimed is Not Unpatentable under 35 USC 103 by the Cited Art.**

Claims 1-3, 5, 6, 17, 19-23 and 25-30 have been rejected under 35 USC 103(a) as being unpatentable over US Patent No. 5893179 to Johnson (Johnson '179) and US Patent No. 3941154 to Bishop (Bishop '154). Claims 1-3, 5, 6, 9-15, 17, and 19-30 have been rejected under 35 USC 103(a) as being unpatentable over US Patent No. 5537696 to Chartier (Chartier '696) and Bishop '154. Claims 1-3, 5, 6, 17, 19-23 and 25-32 have been rejected under 35 USC 103(a) as being

unpatentable over US Patent No. 1398941 to Gable (Gable '941) and US Patent No. 773018 to Kohler (Kohler '018). Applicant respectfully submits that the present invention is patentable over the combinations of prior art cited by the Examiner.

For a claim to be determined obvious (or nonobvious) under 35 USC 103, the claimed material must have been obvious to person of ordinary skill in the art from the prior art. An obviousness determination requires examining (1) the scope of the prior art, (2) the level of skill in the art, and (3) the differences between the prior art and Applicant's invention. *Litton Systems, Inc. v. Honeywell, Inc.*, 117 SCt 1270 (1970). A mere suggestion to further experiment with disclosed principles would not render obvious an invention based on those principles. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 19 USPQ2d 1432 (Fed. Cir. 1991). In fact, an applicant may use a reference as his basis for further experimentation and to create his invention. *Id.*

The fact that each element in a claimed invention is old or unpatentable does not determine the nonobviousness of the claimed invention as a whole. *See Custom Accessories, Inc., v. Jeffrey-Allan Industries*, 1 USPQ2d 1196 1986 (Fed. Cir. 1986). The prior art must not be given an overly broad reading, but should be read in the context of the patent specifications and **as intended by reference authors**. *Durling v. Spectrum Furniture Co.*, 40 USPQ2d 1788 (Fed Cir 1996) (Federal Circuit held that district court erred by giving a "too broad an interpretation" of claims in a sofa patent to invalidate another on the nonobviousness standard).

The Federal Circuit has defined and determined the bounds of the prior art to be identical for both nonobviousness and anticipation purposes. *See In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994). Prior art for these purposes is pertinent art recognized by persons of ordinary skill to be in the **field of the invention**. *See In re Spada* 15 USPQ2d 1655, 1657 (Fed.Cir.1990), *In re Horne*, 203 USPQ 969, 971 (CCPA 1979). Prior art is pertinent if persons of ordinary skill in the art would have consulted art in that field to develop the invention given the nature of the problem. *See In re Paulsen*, 31 USPQ2d 1671 (Fed. Cir. 1994). Specifically, the pertinence of any reference is dependent upon whether it would suggest to persons skilled in the art to do the thing that the applicant has done, and the same is true in considering more than one reference or a reference alleged not to be in the particular art. *See In re Phipps*, 69 USPQ 88 (CCPA 1946). Nonanalogous prior art cannot properly be considered prior art under 35 USC 103. *In re Pagliaro*, 210 USPQ 888, 892 (CCPA 1981).

The Federal Circuit has made it clear that the nonobviousness standard is applied wrongly if a court or an examiner: (1) improperly focuses on "a combination of old elements" rather than the invention as a whole; (2) ignores objective evidence of nonobviousness; (3) pays lip service to the presumption of validity; and (4) fails to make sufficient *Graham* findings. *Custom Accessories, Inc.*, 1 USPQ2d 1196 (Fed. Cir. 1986). Applying the nonobviousness test counter to these principles counters the principle that a patent application is presumed nonobvious. *Id.*

To sustain a rejection under 35 USC 103, the examiner must establish a *prima facie* case of obviousness. MPEP §2142. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. This just is not the case with the present invention. As the present invention is not fairly taught by or related to the subject matter of the cited prior art, it cannot and does not make obvious the present invention as claimed, and Applicant requests that this ground for rejection be withdrawn.

**A. Claims 1-3, 5, 6, 17, 19-23 and 25-30 Are Not Obvious Under 35 USC 103 By Johnson '179 in view of Bishop '154.**

Applicant restates the remarks noted above in 3.A. related to the discussion of Johnson '179 herein.

Applicant notes that it is unable to ascertain any motivation for one of ordinary skill in the art to combine these prior arts. Johnson '179 discloses a sheet style waterfall device whereas Bishop '154 discloses a mechanism including a series of inlets and outlets to provide circulation in a pool. Applicant respectfully submits that there is no legitimate motivation for one of ordinary skill in the art to combine these references.

Further, the inlet conduit of Bishop '154 is on the pool's interior whereas the source water for both the present invention and Johnson '179 is behind the pool wall. Thus, the teachings are not so similar that one of ordinary skill in the art of waterfall devices such as Johnson '179 and the present invention would consult with a prior art dealing solely with the issue of providing easier access to piping as taught in Bishop '154.

Applicants also note that Bishop '154 and Johnson '179 are in different U.S. Classes, different international classes, they have no common Fields of Search and

that Johnson '179, which issued in 1999, does not reference Bishop '154, which issued in 1976. Other than the fact that both devices circulate water, they have very little in common and Applicant submits that one of ordinary skill in the art of waterfall devices such as the present application would not consult with a circulation system device as in Bishop '154. As there is no apparent motivation to combine these prior art documents, Applicant respectfully requests that the Examiner remove the rejections.

Further, even if they were combinable, they do not teach each and every element of applicants pending claims as they do not teach an elongated member at a distance from a water structure to produce a waterfall as in currently amended independent Claims 1, 17, and 19 and claims that depend therefrom, including Claims 2-3, 5, 6, 20-23 and 25-30. Because the cited prior arts do not fairly teach each element of the pending claims, Applicant requests that the Examiner remove the rejections.

The Examiner cites Bishop '154 for teaching "an analogous water structure device which further includes an elongated member 20 disclosed as being used as a handle (col. 1 Ins 37-45)." Applicant disagrees with the Examiner's interpretation of the teachings of Bishop '154. Bishop '154 discloses a water circulation system for use in pools and similar structures including a plurality of inlets and a plurality of outlets. The inlets are connected to each other by a series of conduits. The language that the Examiner cites discusses Bishop '154's preference for locating the **Inlet conduits** connecting the inlets together on the inside of the pool at about the **normal** water level so that easy access to the conduits and inlets is available for future maintenance. The disclosure indicates that the **inlet conduits** may be situated at a distance from the water structure to provide a finger hold or hand rail around the pool. Applicant notes that as the disclosure is related to **inlet conduits**, they are **necessarily** situated at the **normal water level or below** in order to permit water to enter, thus they **could not** be situated **above** the normal water level as in the present invention which is for a waterfall device that is placed above the normal water level in order to produce a waterfall.

Further, the elongated member 20 of Bishop '154 is an inlet conduit and **not** a waterfall outlet as in each of the pending claims. Thus, there is no teaching of an elongated outlet member above the normal water level in the water structure and at a distance from the water structure as in the pending independent Claims 1, 17, and

19 and claims that depend therefrom, including Claims 2-3, 5, 6, 20-23 and 25-30. Because the cited prior arts do not fairly teach each element of the pending claims, Applicant requests that the Examiner remove the rejections.

For the above reasons, Applicant requests that the Examiner withdraw the grounds for rejection and find the pending claims allowable.

**B. Claims 1-3, 5, 6, 9-15, 17, and 19-30 Are Not Obvious Under 35 USC 103 By Chartier '696 in view of Bishop '154.**

Applicant restates the remarks noted above in 3.B. related to the discussion of Chartier '696 herein.

Applicant notes that it is unable to ascertain any motivation for one of ordinary skill in the art to combine these prior arts. Chartier '696 discloses a sheet style waterfall device whereas Bishop '154 discloses a mechanism including a series of inlets and outlets to provide circulation in a pool. Applicant respectfully submits that there is no legitimate motivation for one of ordinary skill in the art to combine these references.

Further, the inlet conduit of Bishop '154 is on the pool's interior whereas the source water for both the present invention and Chartier '696 is behind the pool wall. Thus, the teachings are not so similar that one of ordinary skill in the art of waterfall devices such as Chartier '696 and the present invention would consult with a prior art dealing solely with the issue of providing easier access to piping as taught in Bishop '154.

Applicants also note that Bishop '154 and Chartier '696 are in different U.S. Classes, different international classes, they have no common Fields of Search and that Chartier '696, which issued in 1996, does not reference Bishop '154, which issued in 1976. Other than the fact that both devices circulate water, they have very little in common and Applicant submits that one of ordinary skill in the art of waterfall devices such as the present application would not consult with a circulation system device as in Bishop '154. As there is no apparent motivation to combine these prior art documents, Applicant respectfully requests that the Examiner remove the rejections.

Further, even if they were combinable, they do not teach each and every element of applicants pending claims as they do not teach an elongated member at a distance from a water structure to produce a waterfall as in currently amended

independent Claims 1, 9, 17, and 19 and claims that depend therefrom, including Claims 2-3, 5, 6, 10-15, and 20-30. Because the cited prior arts do not fairly teach each element of the pending claims, Applicant requests that the Examiner remove the rejections.

The Examiner cites Bishop '154 for teaching "an analogous water structure device which further includes an elongated member 20 disclosed as being used as a handle (col. 1 Ins. 37-45)." Applicant disagrees with the teachings of Bishop '154. Bishop '154 discloses a water circulation system for use in pools and similar structures including a plurality of inlets and a plurality of outlets. The inlets are connected to each other by a series of conduits. The language that the Examiner cites discusses Bishop '154's preference for locating the **Inlet conduits** connecting the inlets together on the inside of the pool at about the **normal** water level so that easy access to the conduits and inlets is available for future maintenance. The disclosure indicates that the **inlet conduits** may be situated at a distance from the water structure to provide a finger hold or hand rail around the pool. Applicant notes that as the disclosure is related to **inlet conduits**, they are **necessarily** situated at **the normal water level or below** in order to permit water to enter, thus they **could not** be situated **above** the normal water level as in the present invention which is for a waterfall device that is placed above the normal water level in order to produce a waterfall.

Further, the elongated member 20 of Bishop '154 is an inlet conduit and **not** a waterfall outlet as in each of the pending claims. Thus, there is no teaching of an elongated outlet member above the normal water level in the water structure and at a distance from the water structure as in the pending independent Claims 1, 9, 17, and 19 and claims that depend therefrom, including Claims 2-3, 5, 6, 10-15, and 20-30. Because the cited prior arts do not fairly teach each element of the pending claims, Applicant requests that the Examiner remove the rejections.

With regard to pending Claim 9 (and claims that depend therefrom, including Claims 10-15), Applicant submits that neither art teaches a rotatable elongated outlet member for producing a waterfall as in pending Claim 9. Because the cited prior arts do not fairly teach each element of the pending claims, Applicant requests that the Examiner remove the rejections.

For the above reasons, Applicant requests that the Examiner withdraw the grounds for rejection and find the pending claims allowable.

**C. Claims 1-3, 5, 6, 17, 19-23 and 25-32 Are Not Obvious Under 35 USC 103 By Gable '941 in view of Kohler '018.**

Applicant restates the remarks noted above in 3.C. related to the discussion of Gable '941 herein.

Applicant notes that it is unable to ascertain any motivation for one of ordinary skill in the art to combine these prior arts. Gable '941 discloses a combination water nozzle whereas Kohler '018 discloses double bell supply. Applicant respectfully submits that there is no legitimate motivation for one of ordinary skill in the art to combine these references, and, even if they are properly combinable, the combination does not teach the present invention as claimed.

Applicant notes that neither of the cited references teaches a first end piece and a second end piece holding an elongated member **at a distance** from the water structure so that the device functions as a handle for a user of the water structure as found in pending claim 1 (from which Claims 2, 3, 5, 6, 31 and 32 depend).

Applicant further notes that neither of the cited references teaches a first end piece and a second end piece holding an elongated member at a distance from the water structure so that the device functions as a handle for a user of the water structure as found in pending Claim 17.

Applicant even further notes that neither of the cited references teaches a first end piece and a second end piece holding an elongated member at a distance from the water structure so that the device functions as a handle for a user of the water structure as found in pending Claim 19 (from which Claims 20-23 and 25-30 depend).

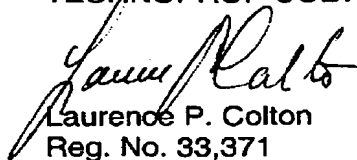
For the above reasons, Applicant requests that the Examiner withdraw the grounds for rejection and find the pending claims allowable.



**CONCLUSION**

Applicant submits that the claims are in condition for allowance and respectfully requests such action. If the examiner has any questions that can be resolved over the telephone, the examiner is invited to contact the below-signed attorney of record.

Respectfully submitted,  
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